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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,133	12/05/2003	Stephanie D. Waldrop	22530-RA1	8985
30184	7590	11/17/2004		
MYERS & KAPLAN, INTELLECTUAL PROPERTY LAW, L.L.C. 1899 POWERS FERRY ROAD SUITE 310 ATLANTA, GA 30339				EXAMINER ANTHONY, JOSEPH DAVID
			ART UNIT 1714	PAPER NUMBER

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/729,133	WALDROP ET AL. <i>TH</i>	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph D. Anthony	1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
  - 4a) Of the above claim(s) 14 and 19-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-13 and 15-18 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13 and 15-18, drawn to a composition and method of making, classified in class 252, subclass 372.
  - II. Claim 14, drawn to a method for sterilizing articles, classified in class 422, subclass 34.
  - III. Claims 19-21, drawn to a composition that is different from the composition of Group I, classified in class 252, subclass 8.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used as a blowing agent.
3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the compositions of Group III can comprise nonafluoro-1-iodobutane, bromodifluoromethane and nitrogen, whereas Group I compositions require iodotrifluoromethane, ethylene oxide and carbon dioxide.

4. Inventions III and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the Inventions III and II are unrelated since Invention I is drawn to a method of using the composition of Group I and not to a method of using the composition of Group III.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Thomas r. Williamson III on 08/17/04 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-13 and 15-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 14 and 19-21 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is deemed to be confusing in terms of the phrase "flammability suppressant consisting of" as set forth in line 2 of the claim. Does applicant mean to use "comprising" instead of "consisting of" since "comprising" is used to describe the flammability suppressant as set forth in dependent claim 4. Also all the inert propellants of dependent claims 8-11, except for air, are known to function as flammability suppressants.

Claim 2 is indefinite due to the use of the phrase "further comprising" since the blend pressure is not an additional component but rather a statement of the physical characteristics of the composition already claimed in independent claim 1.

Claim 3 is indefinite because the claimed concentration ranges is improper because it relates to the concentration range of the ethylene oxide component when the claimed composition of independent claim 1 is being used in a

sterilizing method and not to the concentration of the ethylene oxide component as found within the claimed composition of independent claim 1.

Claim 4 is indefinite because the word ‘further’ in line 1 needs to be canceled. Furthermore, the claim is indefinite because there is no antecedent basis for the phrase “of said at least one “ as set forth in line 3 of the claim. Finally, claim 4 is indefinite because the use of the word “comprises” in line 5 of the claim is in direct conflict with the phrase “consisting of” as set forth in line 2 of independent claim 1.

Claims 8-11 are indefinite because all the inert propellants of dependent claims 8-11, except for air, are known to function as flammability suppressants and are thus excluded by applicant’s “consisting of” claim language as set forth in line 2 of independent claim 1.

All the other said claims are being rejected here because they are dependent on a rejected base claim.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-7 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nimitz et al. U.S. Patent Number 5,674,451.

Nitmitz et al teaches sterilization compositions and methods of sterilization of articles using the same. The method comprises contacting an article with a blend comprising an ethylene oxide sterilant and a propellant which comprises a fluoroiodocarbon, such as trifluoriodomethane. The propellant preferably comprises an admixture of a primary propellant and a fluoroiodocarbon, wherein the primary propellant can be carbon dioxide, nitrogen, hydrochlorofluorocarbons and/or hydrofluorocarbons. Carbon dioxide is a preferred primary propellant, see abstract, Table 4, and claims 1 and 4-9. Also see Example 13, which teaches a spray can of household disinfectant is pressurized with a mixture of 4% trifluoriodomethane and 96% carbon dioxide. Because of the use of the fluoroiodocarbon blend as propellant, any flammability risk is eliminated. Likewise, EXAMPLE 14 teaches a gas mixture consisting of 5% (by moles) trifluoriodomethane, 12% ethylene oxide, and 83% nitrogen is used to sterilize bandages, gauze pads, and medical equipment. Because of the addition of the trifluoriodomethane as a supplemental propellant, the danger of fire or explosion during the process is eliminated. Applicant's invention is deemed to be directly anticipated over Nimitz et al's Example 13 if the sterilant in Example 13 is

actually ethylene oxide, the only sterilant species disclosed by the Nimitz et al's patent, but not directly stated in Example 13. In the alternative, applicant's invention is deemed to be extremely obvious over Nimitz et al's Example 13, since it would have been obvious to one having ordinary skill in the art to use ethylene oxide as the sterilant in the Example 13 since it is so well known in the art and is the only sterilant disclosed by the patent, see Example 14 and claim 1 for support. Furthermore, applicant's invention would be extremely obvious Example 14, when the nitrogen primary propellant is replaced by carbon dioxide as the primary propellant. Carbon dioxide is directly taught and claimed by Nimitz et al as a highly preferred primary propellant, see Example 13 and Claim 9 for support.

14. Claims 8-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nimitz et al. U.S. Patent Number 5,674,451.

Nimitz et al has been described above and differ from applicant's claimed invention in that there is no direct teaching (i.e. by way of an example) to sterilizing compositions that actually further comprise one or more of the inert propellant/additives as set forth in these claims. It would have been extremely obvious to one having ordinary skill in the art to use one or more of applicant's claimed inert propellant/additives, since such propellant/additives are directly disclosed and claimed by the Nimitz et al patent as useful additional components

to the claimed sterilization method, see claims 1-10, especially claim 7, for direct support.

***Double Patenting***

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 1-13 and 15-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6 and 11 of copending Application No. 10/752,291. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of S.N. 10/729,133 are deemed to extensively overlap the claims of copending application S.N. 10/752,291.

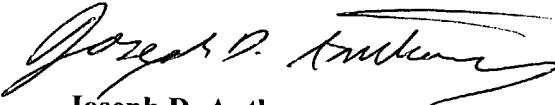
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Prior-Art Cited But Not Applied***

17. Any prior-art reference which is cited on FORM PTO-892 but not applied, is cited only to show the general state of the prior-art at the time of applicant's invention.

***Examiner Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. This examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 6:30 p.m. in the eastern time zone. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

  
Joseph D. Anthony  
Primary Patent Examiner  
Art Unit 1714

11/15/04